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FOLEY & LARDNER LLP			WORONKO, NICHOLAS F	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/990,359

Applicant(s)

MOSTAFA, MIRAJ

Examiner

Nicholas F. Woronko

Art Unit

2169

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-16 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution After Pre-Appeal Brief

In view of the Pre-Appeal Brief filed on June 8, 2009, PROSECUTION IS HEREBY REOPENED. A new application of the cited references is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Eddie C. Lee, a Supervisory Patent Examiner (SPE), has approved of reopening prosecution by signing the Notice of Panel Decision from the Pre-Appeal Brief Review, dated June 18, 2009.

/Tony Mahmoudi/

Supervisory Patent Examiner, Art Unit 2169

Remarks

In response to the August 14, 2008 Office Action, the Applicant has amended claims 1, 6, 11-13 and 23, cancelled claim 8, and added no new claims. Thus, claims 1-7, 9-16 and 19-23 are currently pending in the present Application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-16 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liwerant et al. (US 2002/0056123), hereinafter 'Liwerant', in view of Fukasawa et al. (US 6,738,822), hereinafter 'Fukasawa', further in view of the Applicant's Acknowledged Prior Art (See **Background** of the Present Application), hereinafter 'AAPA'.

With respect to claim 1, Liwerant discloses a method comprising:
receiving media content in a network entity from a sending entity and addressed to at least one recipient, the media content relating to multimedia messaging (See [0049], [0055], Figs. 1A & 1B, Note [0045]: An HTML message (1300) including a video segment is received in a server (21 + 30 + 40) from a network and addressed to a user (10));

accessing, by the network entity, a database comprising recipient data describing at least one of multimedia reception capabilities and multimedia reception preferences for at least one recipient (See [0051-0053], Fig. 1B (Services Desired): The server (21 + 30 + 40) accesses the HTML message (1300) describing multimedia preferences including the streaming video format that the video segment should be converted into, resolution, transmission bitrate, and video quality, as well as, multimedia preferences regarding the display format of the video segment to be displayed on the user's (10) computer including the size of the display in pixels or in linear measure, what portion of the screen is to be used, location on the screen, whether the full-screen is to be used, etc., the message and associated information inherently stored in a database);

forming, in the network entity and in accordance with said at least one of multimedia reception capabilities and reception preferences, a notification message containing information that said media content is available to be streamed to said at least one addressed recipient (See [0048], [0055], [0061], Figs. 1A & 1B: The server (21 + 30 + 40) forms a notification message (1440) including an identifier and pertinent information associated with the requested video segment and preferences thereof, for notifying the user (10) that the video segment is available to be streamed to the user (10));

transmitting, by the network entity, the notification message to said at least one addressed recipient (See [0048], [0055], [0061], Figs. 1A & 1B: The server (21 + 30 + 40) sends the notification message (1440) to the user (10) by email, HTML message, instant message, etc., notifying the user (10) that the video segment is available to be streamed to the user (10)); and

streaming the media content that is available to the at least one addressed recipient (See Fig. 1B (1460), [0055], [0048]: The video segment is streamed to the user (10)).

However, Liwerant fails to explicitly disclose translating, by the network entity, at least one component of the media content while being streamed to the at least one addressed recipient into a format appropriate for said at least one addressed recipient for transmission of said at least one component to said at least one addressed recipient.

Fukasawa, though, discloses a network entity that translates at least one component of media content while being streamed to at least one addressed recipient into a format appropriate for said at least one addressed recipient for transmission of said at least one component to said at least one addressed recipient (See [Col. 5 Lines 1-20], [Col. 3 Lines 4-19]: A conversion server (109, 208, etc.) translates MPEG, Motion JPEG, etc., formatted video, streamed from a video server (102, 201, etc.), into an HTTP message format appropriate for a video client (103, 204, etc.)).

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art to modify the functionality of the network entity, as disclosed by Liwerant, to include translating at least one component of media content while being streamed to at least one addressed recipient into a format appropriate for said at least one addressed recipient, as disclosed by Fukasawa, in order to "[absorb the] difference in communication format between the video delivery system and the World Wide Web system," "[prevent] reduction in execution efficiency due to integration of the video client and a Web browser," and "realize a general-purpose video client," as suggested by Fukasawa (See [Col. 19 Lines 12-20]).

Despite the foregoing teachings, neither Liwerant nor Fukasawa explicitly states that the network entity communicates with the at least one addressed recipient over a radio communications network.

However, the AAPA acknowledges that communication by a network entity over a radio communications network was well known to those of ordinary skill in the pertinent art at the time of the invention (See [Page 2, Lines 25-27], Fig. 1).

Accordingly, one obvious, and advantageous, choice amongst a finite number of identified, predictable solutions, to a person having ordinary skill in the pertinent art at the time of the invention, would have been to communicate, by a network entity, as disclosed by both Liwerant and Fukasawa, over a radio communications network (See MPEP 2141 citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

With respect to claim 2, all the limitations of claim 1 from which claim 2 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Fukasawa discloses receiving the media content in a multimedia messaging server; and providing the at least one addressed recipient with the media content via the network entity, wherein the network entity is a multimedia messaging relay (See Figs. 1, 2, 3, 4 & 5, Note [Col. 5 Lines 1-20], [Col. 3 Lines 4-19]).

In addition, the AAPA, likewise, discloses receiving the media content in a multimedia messaging server; and providing the at least one addressed recipient with the media content via the network entity, wherein the network entity is a multimedia messaging relay (See Fig. 1, Note [Page 2, Lines 4-31]).

With respect to claims 3 and 4, all the limitations of claim 1 from which claims 3 and 4 depend have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Liwerant discloses that a streaming session is established, and at least some of the media content is streamed to said at least one recipient, wherein said establishing of a streamed session is preceded by transmitting the notification message to said at least one addressed recipient (See *supra*).

In addition, Fukasawa, likewise, discloses that a streaming session is established, and at least some of the media content is streamed to said at least one recipient, wherein said establishing of a streamed session is preceded by transmitting a notification message to said at least one addressed recipient (See Fig. 7, Note [Col. 12 Line 58 - Col. 14 Line 4], [Col. 6 Lines 64-67], etc.).

With respect to claim 5, all the limitations of claims 1 and 2 from which claim 5 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Fukasawa discloses that the media content comprises a set of different types of components and each component is formatted in one or more formats (See [Col. 5 Lines 1-20]: One streamed video may be formatted according to MPEG, while another streamed video may be formatted according to Motion JPEG, etc.).

With respect to claim 6, all the limitations of claims 1, 2 and 5 from which claim 6 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Fukasawa discloses that translating at least one component comprises: checking the format of at least one component of the received media content; determining by the recipient data whether the format is appropriate for said at least one addressed

recipient; responsive to determining that the format is not appropriate for said at least one addressed recipient, translating the component into a format appropriate for said at least one addressed recipient (See [Col. 5 Lines 1-20], [Col. 3 Lines 4-19]: The conversion server (109, 208, etc.) determines that video, streamed from the video server (102, 201, etc.), is formatted according to MPEG, Motion JPEG, etc., and also, must inherently determine that MPEG, Motion JPEG, etc., formatted video is not a format appropriate for the video client (103, 204, etc.), since otherwise, conversion by the conversion server (109, 208, etc.) would be unnecessary).

With respect to claim 7, all the limitations of claim 1 from which claim 7 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Liwerant discloses that the notification message provides a minimum amount of information necessary for said at least one addressed recipient to establish a streaming session with the said network entity (See [0048], [0055], [0061], Figs. 1A & 1B: The server (21 + 30 + 40) sends the notification message (1440) including, for example, a URL of the video segment, to the user (10) notifying the user (10) that the video segment is available to be streamed, such that the video segment is streamed to the user (10) simply by accessing the URL).

In addition, Fukasawa, likewise, discloses that a notification message provides a minimum amount of information necessary for said at least one addressed recipient to establish a streaming session with the said network entity (See Fig. 7 (S709), [Col. 13 Lines 28-29]: A connection ID provides a minimum amount of information necessary to establish a session between the conversion server (109, 208, etc.), video server (102, 201, etc.) and video client (103, 204, etc.)).

With respect to claim 9, all the limitations of claim 1 from which claim 9 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and the AAPA discloses that said sending entity is chosen from a group consisting of: a media storing entity of a first telecommunication network, a media storing entity of a second telecommunications network, a media storage in an external data transmission network, and a terminal of the first telecommunication network (See Fig. 1, Note [Page 2, Lines 4-31]).

In addition, Fukasawa, likewise, discloses that said sending entity is chosen from a group consisting of: a media storing entity of a first telecommunication network, a media storing entity of a second telecommunications network, a media storage in an external data transmission network, and a terminal of the first telecommunication network (See Figs. 1, 2, 3, 4 & 5, Note [Col. 5 Lines 1-20], [Col. 3 Lines 4-19]).

With respect to claim 10, all the limitations of claims 1 and 9 from which claim 10 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Fukasawa discloses that the sending entity is selected from the group consisting of a media storing entity of a first telecommunications network and a terminal of the first telecommunications network, wherein the first telecommunication network possesses given properties (See Figs. 1, 2, 3, 4 & 5), and wherein the method further comprises transmitting the notification message to said at least one addressed recipient via a first telecommunications network and forming said notification message taking into account the properties of the first telecommunications network (See Fig. 7, Note Figs. 1, 2, 3, 4 & 5).

With respect to claim 15, all the limitations of claims 1, 9 and 10 from which claim 15 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Fukasawa discloses that the first telecommunication network possesses multimedia capabilities, traffic condition, and processing resources, and wherein the said properties of the first telecommunications network contain at least one or more of the following: the first telecommunications network's multimedia capabilities, the first telecommunications network's traffic condition, and the availability of processing resources in the first telecommunications network (See Figs. 1, 2, 3, 4 & 5).

With respect to claim 16, all the limitations of claim 1 from which claim 16 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and the AAPA discloses that the receiving of the media content from a sending entity includes forwarding the media content, via said network entity, to a multimedia messaging server corresponding to a communication system of said network entity (See Fig. 2, Note [Page 3 Line 4 - Page 4 Line 2]).

In addition, Fukasawa, likewise, discloses that the receiving of the media content from a sending entity includes forwarding the media content, via said network entity, to a multimedia messaging server corresponding to a communication system of said network entity (See Fig. 6: Forwarding video to and from a conversion server (604) from and to a sub-conversion server (605)).

With respect to claim 19, all the limitations of claim 1 from which claim 19 depends have been addressed above in view of Liwerant, Fukasawa and the AAPA, and Liwerant discloses that the forming of the notification message and the outputting of

the notification message are performed locally within a multimedia messaging service environment (See *supra*).

In addition, Fukasawa, likewise, discloses that the forming of the notification message and the outputting of the notification message are performed locally within a multimedia messaging service environment (See [Col. 13 Lines 22-32], Fig. 7).

With respect to claims 11-14 and 20-23, claims 11, 12, 13 and 23 and claims 20, 21 and 22 include limitations similar to those of claims 1 and 19, and are therefore substantially equivalent, and likewise, claim 14 includes limitations similar to those of claim 5, and is therefore substantially equivalent. Thus, for at least those reasons, as discussed with regard to claims 1, 5 and 19, claims 11-14 and 20-23 are also rejected.

Response to Arguments

The Applicant's arguments have been fully considered, however, are moot in view of the new application of the cited references.

Conclusion

The Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** (See MPEP 706.07(a), MPEP 1207.04). The Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas F. Woronko whose telephone number is (571) 270-3553. The examiner can normally be reached on Monday-Thursday: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. F. W./
Nicholas F. Woronko
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/Tony Mahmoudi/
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